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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,838	07/27/2001	Henry T. Fung	A-67379-1/RMA	9117

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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/916,838	<b>Applicant(s)</b> FUNG ET AL.	
	<b>Examiner</b> Paul Callahan	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,42,44,50,52-56,60 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,42,44,50,52-56,60 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Amendment**

1. Claims 1 and 42-65 were pending in this application at the time of the previous Office Action. Claims 1-41 have been previously cancelled by preliminary amendment. Claims 43, 45-49, 51, 57-59, 61-63, and 65 have been cancelled by the latest amendment. Therefore, claims 1, 42, 44, 50, 52-56, 60, and 64 are pending and have been examined.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenthal et al. (US 5,784,460), and Takaragi et al. (5,117,458).

As per claim 1, the claimed invention teaches a system where a client computer sends a public PIN, user-specific information, and device specific information to enable a server to appropriately configure content to be downloaded to the client.

The system of Takaragi discloses a system where software is stored at a content server and distributes to remote users (Abstract). Takaragi teaches the further limitations of associating in the server a client identifier, with content attributes appropriate for each said client device

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having said different client identifier (abstract, fig. 4 item 1203, col. 9 lines 1-21). Takaragi teaches the content server recognizing the hardware and or software characteristics of the client device and customizing the content for compatibility with the client device (Abstract, fig. 4 item 1203).

Blumenthal discloses the limitations not taught by Takaragi, i.e., a remote server that receives a unique password (PIN), user specific information such as software product item numbers, and device specific information such as hardware serial numbers (abstract, col. 4 lines 10-25). The server of Blumenthal uses the received information to generate a decryption key to be downloaded to the client (abstract, col. 4 lines 22-27); the client uses the generated decryption key to decrypt a specified encrypted product (col. 4 lines 27-28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of Blumenthal into the system of Takaragi. It would have been desirable to do so as the use of a client ID containing device specific information and associated in the content server would allow more rapid provision of software content to a client.

4. Claims 42, 44, 50, 52-56, 60, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenthal et al., Takaragi et al., and Fielding et al., RFC 2068, Network Working Group, "Hypertext Transfer Protocol HTTP/1.1, Jan. 1997, Sec. 12.1: Content Negotiation.

Claim 42, as amended by the latest amendment, is previously presented claim 42 now incorporating the limitations of claim 43. Claim 43 was indicated in the previous Office Action in the case as allowable if written in independent form and incorporating the limitations of claim 42.

That indication of allowability is now withdrawn in view of the new grounds of rejection presented below.

As for claims 42 and 44, the claimed invention teaches a system where a client computer sends a public PIN, user-specific information, and device specific information to enable a server to appropriately configure content to be downloaded to the client.

The system of Takaragi discloses a system where software is stored at a content server and distributes to remote users (Abstract). Takaragi teaches the further limitations of associating in the server a client identifier, with content attributes appropriate for each said client device having said different client identifier (abstract, fig. 4 item 1203, col. 9 lines 1-21). Takaragi teaches the content server recognizing the hardware and or software characteristics of the client device and customizing the content for compatibility with the client device (Abstract, fig. 4 item 1203). Takaragi teaches a device-specific information that comprises an identifier that is automatically transmitted to said server in clear-text form when the client device is connected (directly) to the network (col. 10 lines 30-35).

Blumenthal discloses the limitations not taught by Takaragi, i.e., a remote server that receives a unique password (PIN), user specific information such as software product item numbers, and device specific information such as hardware serial numbers (abstract, col. 4 lines 10-25). The server of Blumenthal uses the received information to generate a decryption key to be downloaded to the client (abstract, col. 4 lines 22-27); the client uses the generated decryption key to decrypt a specified encrypted product (col. 4 lines 27-28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of Blumenthal into the system of Takaragi. It would have been desirable to do so as the use of a client ID containing device specific information and associated in the content server would allow more rapid provision of software content to a client.

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The combination of Takaragi and Blumenthal fail to teach the transmission of device specific information that can be used by said server to customize said content so that it is suitable for at least processor, display, and available memory size attributes of said client, and date of manufacture of said client, and where such can be used by the server to limit client access to content and where the client access rights and device attributes are dynamically modifiable. However Fielding et al., do teach these features (Sec. 12.1 Content Negotiation). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Takaragi and Blumenthal. It would have been desirable to do so as this would allow for the utilization to the standard transfer protocol used in network communications.

Claim 50 has been amended by the latest amendment to incorporate the limitations of originally presented claim 42, with the incorporation of the limitations of now cancelled claim 46. Originally presented claim 50 was indicated as allowable in the previous Office Action if rewritten in independent form incorporating the limitations of its base claim 42 and intervening claim 46. That indication is now withdrawn in light of the new grounds of rejection presented below.

As for claim 50, the combination of Takaragi and Blumenthal teaches the limitations of claim 42 that are common to claim 50. Takaragi et al. teaches a feature of the claim not found in common with originally presented claim 42, namely a device identifier that is automatically communicated to the server when the client device is coupled to the network (col. 10 lines 30-35).

Claim 52, as amended by the latest amendment it is previously presented claim 52 now presented in independent form and with the incorporation of the limitations of original claims 42 and 46 incorporated. Claim 52 was indicated as allowable in the previous Office Action in presented in independent form with the incorporation of its base claim (42) and any intervening claim (46). Upon further consideration of the prior art, The Examiner has withdrawn that indication of allowability in light of the new grounds of rejection presented below.

In claim 52, the claimed invention teaches a system where a client computer sends a public PIN, user-specific information, and device specific information to enable a server to appropriately configure content to be downloaded to the client. The system of Takaragi discloses a system where software is stored at a content server and distributes to remote users (Abstract). Takaragi teaches the further limitations of associating in the server a client identifier, with content attributes appropriate for each said client device having said different client identifier (abstract, fig. 4 item 1203, col. 9 lines 1-21). Takaragi teaches the content server recognizing the hardware and or software characteristics of the client device and customizing the content for compatibility with the client device (Abstract, fig. 4 item 1203). Takaragi teaches a device-specific information that comprises an identifier that is automatically transmitted to said server in clear-text form when the client device is connected (directly) to the network (col. 10 lines 30-35). Blumenthal discloses the limitations not taught by Takaragi, i.e., a remote server that receives a unique password (PIN), user specific information such as software product item numbers, and device specific information such as hardware serial numbers (abstract, col. 4 lines 10-25). The server of Blumenthal uses the received information to generate a decryption key to be downloaded to the client (abstract, col. 4 lines 22-27); the client uses the generated decryption key to decrypt a specified encrypted product (col. 4 lines 27-28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the

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invention to incorporate the features of Blumenthal into the system of Takaragi. It would have been desirable to do so as the use of a client ID containing device specific information and associated in the content server would allow more rapid provision of software content to a client.

Claims 53 and 54, as presented by the latest amendment, are previously presented claims 53 and 54 now written in independent form with the incorporation of the limitations of original claim 42. Claims 53 and 54 were indicated as allowable in the previous Office Action if presented in independent form with the incorporation of its base claim (42). The Examiner has withdrawn that indication of allowability in light of the new grounds of rejection presented below.

As for claims 53-56, the combination of Blumenthal and Takaragi teaches all of the limitations of the claims held in common with claim 42, but fails to teach a client device that is adapted to dynamically modify said device specific information, where said modification comprises modification of a field within said DID to allow the server to construct a response commensurate with the clients memory size, before it is transmitted to the server so that the content may be filtered and communicated to said client in accordance with the modified device-specific information. However Fielding et al., do teach these features (Sec. 12.1: Content Negotiation). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Takaragi and Blumenthal. It would have been desirable to do so as this would allow for the utilization to the standard transfer protocol used in network communications.

As for claims 60 and 64, as presented by the latest amendment, they are previously presented claims 60 and 64 now written in independent form and with the incorporation of the limitations of original claim 42. The claims were indicated as allowable in the previous Office



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Action if presented in independent form with the incorporation of its base claim (42). Upon further consideration of the prior art, The Examiner has withdrawn that indication of allowability.

As for claims 60 and 64, the combination of Takaragi and Blumenthal teaches all of the limitations of the claims held in common with claim 42. Fielding et al. teach the remaining limitations, namely content customization that comprises reduction in the complexity and amount of content, where device characteristics are identified by reference to an external database by said server using said DID, where said UMID is communicated without security precautions, and where the DID may be dynamically modified (Sec. 12.1 Content Negotiation). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Takaragi and Blumenthal. It would have been desirable to do so as this would allow for the utilization to the standard transfer protocol used in network communications.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of digital media delivery similar to that of the applicant:

Sendrow      4,317,957

Kelly          5,636,280

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

1/20/04

*Paul Cullen*

*Andrew Caldwell*

**ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER**